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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/543,086	07/22/2005	Leopold Murhammer	2003P00936	5609
24131 7590 06/23/2009 LERNER GREENBERG STEMER LLP P O BOX 2480 HOLLYWOOD, FL 33022-2480				
EXAMINER				
BRANDT, CHRISTOPHER M				
ART UNIT		PAPER NUMBER		
2617				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/543,086

Applicant(s)

MURHAMMER ET AL.

Examiner

CHRISTOPHER M. BRANDT

Art Unit

2617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 16, 2009 has been entered.

Response to Amendment

This Action is in response to applicant's amendment / arguments filed on April 16, 2009. **Claims 1-11** are still currently pending in the present application.

Response to Arguments

Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2, 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Eloranta (WO 01/60098 A1)** in view of **Tsai et al. (US Patent 6,823,049 B2, hereinafter Tsai)** and further in view of **Kirbas et al. (US PGPUB 2002/0165012 A1, hereinafter Kirbas)**.

Consider **claim 1**. Eloranta discloses a method for deciding whether to intercept a telecommunications connection, comprising:

for an identification detail relating to each of at least one subscriber of the telecommunications connection, checking whether the identification detail is included in at least one identification relating to the subscriber to be monitored which is stored in a list; and

intercepting the telecommunication connection if it is stored in the list (page 5 line 27 – page 6 line 19, page 7 lines 26-27, read as a method for monitoring (intercepting) the communications of a certain equipment or person, wherein for an identification information (preferably MSISDN, IMEI, IMSI) relating to at least one mobile station 1 (figure 1) a check is

made for matching entry of identification information, which is stored in database 5 (figure 1) with interception to be based on any of the parameters stored in the database 5).

Although Eloranta discloses the claimed invention, he fails to suggest that the identification detail is associated with at least one identification detail **abbreviation** relating to each of the at least one subscriber.

However, Tsai discloses identification detail is associated with at least one identification detail **abbreviation** relating to each of the at least one subscriber (figure 2, column 3 lines 61-62, column 5 lines 46-48, read as each of the stored phone call data includes an index code (i.e. abbreviation), where the identification code is judged to determine whether or not is has a filtering flag).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the teachings of Tsai into the method of Eloranta in order reduce the amount of time required for setting and changing screening conditions (column 6 lines 16-19).

In addition, Eloranta and Tsai fail to teach that the identification detail abbreviation represents part of the respective identification detail (Tsai teaches that stored phone call data includes an index code).

However, Kirbas teaches the identification detail abbreviation represents part of the respective identification detail (paragraph 23, read as checking a particular area code of the dialed number to see whether the number is authorized or unauthorized).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the teachings of Kirbas into the invention of Eloranta

and Tsai in order to efficiently program unauthorized numbers into a list thereby saving resources (paragraph 5).

Consider **claim 11**. Eloranta discloses a device for deciding whether to intercept telecommunications connections, comprising:

a list of identification detail relating to telecommunications subscribers to be intercepted stored in a memory;

comparison equipment for comparing identification details transferred over a telecommunications connection relating to subscribers of the telecommunications connection with stored identification detail; and

decision equipment to initiate the monitoring of a telecommunications connection with at least one telecommunications subscriber identified as to be monitored by an identification detail (page 5 line 27 – page 6 line 19, read as a legal interception gateway (LIG) 3 (figure 1) to monitor (intercept) communication connections, with an identifier data relating to a mobile station (figure 1) to be monitored (intercepted) stored in database 5 (figure 1), with matching entry means in the database 5 for identification information cooperates over a communication connection relating to a mobile station 1 with stored identification information, with the legal interception gateway (LIG) 3 to initiate the interception to be based on any of the parameters stored in the database 5).

Although Eloranta discloses the claimed invention, he fails to suggest that the identification detail is associated with at least one identification detail **abbreviation** relating to each of the at least one subscriber.

However, Tsai discloses identification detail is associated with at least one identification detail **abbreviation** relating to each of the at least one subscriber (figure 2, column 3 lines 61-62, column 5 lines 46-48, read as each of the stored phone call data includes an index code (i.e. abbreviation), where the identification code is judged to determine whether or not is has a filtering flag).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the teachings of Tsai into the method of Eloranta in order reduce the amount of time required for setting and changing screening conditions (column 6 lines 16-19).

In addition, Eloranta and Tsai fail to teach that the identification detail abbreviation represents part of the respective identification detail to at least one of the telecommunications subscribers (Tsai teaches that stored phone call data includes an index code).

However, Kirbas teaches the identification detail abbreviation represents part of the respective identification detail to at least one of the telecommunications subscribers (paragraph 23, read as checking a particular area code of the dialed number to see whether the number is authorized or unauthorized).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the teachings of Kirbas into the invention of Eloranta and Tsai in order to efficiently program unauthorized numbers into a list thereby saving resources (paragraph 5).

Consider **claim 2** and **as applied to claim 1**. Eloranta and Tsai disclose a method wherein the identification detail abbreviation is part of an identification detail relating to a

mobile subscriber number (Eloranta; page 5 line 27 – page 6 line 19, page 7 lines 26-371, Tsai; figure 2, column 3 lines 61-62).

Consider **claim 5** and **as applied to claim 1**. Eloranta and Tsai disclose a method wherein the identification detail abbreviation is part of a telecommunications terminal identification (Eloranta; page 5 line 27 – page 6 line 19, page 7 lines 26-37, Tsai; figure 2, column 3 lines 61-62).

Consider **claim 6** and **as applied to claim 1**. Eloranta and Tsai disclose a method wherein the telecommunications connection is routed over a mobile radio network and/or fixed network and/or the Internet (Eloranta; page 5 lines 10-25).

Consider **claim 7** and **as applied to claim 1**. Eloranta and Tsai disclose a method wherein the checking is undertaken by equipment of a telecommunications network over which the telecommunications connection is routed or by equipment connected to it (Eloranta; pages 6 lines 8-19).

Consider **claim 8** and **as applied to claim 1**. Eloranta and Tsai disclose a method wherein the interception is undertaken by official equipment (Eloranta; page 5 lines 27 – page 6 line 6).

Consider **claim 9** and **as applied to claim 1**. Eloranta and Tsai disclose a method wherein identification details are checked when a connection is set up (Eloranta; page 6 lines 8-19).

Consider **claim 10** and **as applied to claim 1**. Eloranta and Tsai disclose a method wherein identification details of telecommunications subscribers are checked on transmission of data packets over a telecommunications connection (Eloranta; page 5 lines 10-25).

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Eloranta (WO 01/60098 A1)** in view of **Tsai et al. (US Patent 6,823,049 B2, hereinafter Tsai)** in view of **Kirbas et al. (US PGPUB 2002/0165012 A1, hereinafter Kirbas)** and further in view of **Helferich (US Patent 6,826,407)**.

Consider **claim 3** and **as applied to claim 1**. Eloranta, Tsai, and Kirbas disclose the claimed invention except wherein the identification detail abbreviation is part of an e-mail address.

However, Helferich discloses a method wherein an identification detail abbreviation is part of an e-mail address of a telecommunications subscriber (abstract, column 9 lines 34-49, read as the replay address may be an e-mail address or an abbreviated e-mail address that is associated with an e-mail address stored at the IMG 150. It is also noted from the abstract that this invention does in fact relate to a mobile communication device for receiving visual messages (e-mails)).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the teachings of Helferich into the methods of Eloranta, Tsai, and Kirbas in order to be able to monitor all possible transmissions of information.

Consider **claim 4** and **as applied to claim 3**. Eloranta, Tsai, and Helferich disclose a method wherein the identification detail abbreviation is a domain name or a part of a domain name in an e-mail address of a telecommunications subscriber (Helferich; column 9 lines 34-49).

Conclusion

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents

P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Brandt whose telephone number is (571) 270-1098.

The examiner can normally be reached on 7:30a.m. to 5p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 2617

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Christopher M. Brandt

C.M.B./cmb

June 19, 2009

/George Eng/

Supervisory Patent Examiner, Art Unit 2617